

REMARKS

I. Status of the Application

Claims 1-12, 15-23, 37-46 and 48-62 are pending in this application. In the June 2, 2006 office action, the examiner rejected claims 1, 3-9, 23, and 53-55 under 35 U.S.C. § 102(b) as allegedly being anticipated by published European patent application 0 318 273 to Karger (hereinafter "Karger"). Although the rejection is unclear, the examiner also appears to have rejected claims 37 and 39-44 under 35 U.S.C. § 102(b) as allegedly being anticipated by Karger. In addition, the examiner rejected claims 2, 10-12, 15-22, 38, 45, 48, 49, and 51 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Karger in view of one or more of U.S. Patent No. 6,640,891 to Oldenburg (hereinafter, "Oldenburg"), U.S. Patent No. 5,965,410 to Chow (hereinafter, "Chow"), U.S. Patent No. 5,641,400 to Kaltenbach et al. (hereinafter, "Kaltenbach"), and/or U.S. Patent No. 6,406,605 to Moles (hereinafter "Moles").

In this response, applicants have amended claims 1, 54, 56 and 57. Applicants respectfully request reconsideration of pending claims 1-12, 15-23, 37-46 and 48-62, in view of the foregoing amendments and the following remarks.

II. Claims 1, 37 and 54

In the June 2, 2006 office action, the examiner rejected claims 1, 37 and 54 under 35 U.S.C. § 102(b) as being anticipated by Karger. As provided in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 USPQ2d 1051, 1053 (Fed. Cir. 1987).

“The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Karger reference does not disclose all the limitations of claims 1, 37 and 54. For example, with respect to claim 1 the Karger reference at least does not disclose a heating unit with “said first surface of said heating unit being at least partially exposed for cooling of said heating unit such that said first surface includes an exposed portion that does not contact another solid surface”. Instead, as shown in Figs. 1 and 3 of Karger, the Karger reference discloses a capillary electrophoretic apparatus 12 including two thermoelectric plates 32, wherein each thermoelectric plate includes a first surface 32 facing a secondary support plate 30 and a second surface facing a heat sink plate 34. The surfaces of the thermoelectric plates 32 of Karger are not exposed, and are instead positioned against the heat sink plates 34. Thus, in contrast to claim 1, Karger does not disclose a heating unit with “said first surface of said heating unit being at least partially exposed for cooling of said heating unit” as required by claim 1.

Claim 37 includes similar limitations to claim 1 with respect to exposed heating unit surfaces. In addition, claim 37 includes other limitations not disclosed in Karger. For example, claim 37 includes the limitation of “a plurality of capillaries extending between said first and second electrode units.” Instead, as shown in FIGs. 1 and 3 of Karger, Karger only discloses a single capillary column 12. Thus, for the same reasons as provided with respect to claim 1, as well as additional reasons Karger does not disclose all the limitations of claim 37. Accordingly, Karger does not anticipate claim 37 of the

present application.

Claim 54 includes similar limitations to claim 1 with respect to exposed heating unit surfaces. Thus, for at least the same reasons as provided with respect to claim 1, Karger does not disclose all the limitations of claim 54.

For at least the reasons discussed above, Karger does not disclose all limitations of claims 1, 37 and 54 of the present application. Accordingly, it is respectfully submitted that claims 1, 37 and 54 are allowable and the examiner's rejection of claims 1, 37 and 54 as anticipated by Karger under 35 U.S.C. § 102(b) should be withdrawn.

III. Dependent Claims 2-12, 15-23, 38-46 and 48-53 and 55-61

Dependent claims 2-12, 15-23, 38-46, 48-53 and 55-61 depend from and incorporate all the limitations of one of allowable independent claims 1, 37, or 54. Accordingly, it is respectfully submitted that dependent claims 2-12, 15-23, 38-46, 48-53 and 55-61 are also allowable for at least the same reasons the independent claims 1, 37 and 54 are allowable. Applicant respectfully submits that claims 2-12, 15-23, 38-46, 48-53 and 55-61 are also allowable for other reasons.

IV. Dependent Claims 46, 50, 52, and 56-59

On the Office Action Summary page of the June 2, 2006 Office action, the examiner indicated that dependent claims 46, 50, 52 and 56-59 were rejected. However, the examiner set forth no grounds for rejection of these claims in the June 2, 2006 Office action. Thus, applicant has not been given the opportunity to analyze or respond to these claim rejections. Because the examiner has failed to provide a rationale for the rejection

of claims 46, 50, 52 and 56-59, it is respectfully submitted that the examiner's rejection of these claims should be withdrawn.

V. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,



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